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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/634,497	08/05/2003	Martin Grohman	34192	8665
7590                      09/15/2005 Hovey Williams LLP Suite 400 2405 Grand Blvd. Kansas City, MO 64108		EXAMINER SLACK, NAKO N		
		ART UNIT                      PAPER NUMBER 3635		
DATE MAILED: 09/15/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/634,497

Applicant(s)

GROHMAN, MARTIN

Examiner

Naoko Slack

Art Unit

3635

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 June 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>2/2/05</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

In view of applicant's amendment received June 20, 2005, corrections to the specification and drawings have been entered. The IDS dated February 2, 2005 has been entered and considered.

Regarding applicant's Declaration swearing behind Eberle's filing date of January 2, 2002, applicant states that the submitted drawing is dated prior to January 3 (Remarks, page 7, line 6 from the bottom). This statement is misleading, as no date can be found on the drawing. However, in view of applicant's declaration, prior art to Eberle has been removed, and a new rejection of the claims is herein presented.

### ***Specification***

On page 1, paragraph 1 of the specification purports to claim priority benefit from another US application; however, both applications have the same filing date. Therefore, there is no priority benefit. Correction is required.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Art Unit: 3635

Claims 1-5, 7, 10-13, and 16 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by US Patent 6,314,699B1 to West.

Claims 1 and 11:

West discloses a deck system comprising a plurality of laterally spaced joists (14, Figure 1), a plurality of deck boards (16, Figure 1), each board comprising an elongated body presenting a pair of similarly configured sides (Figure 6), each of said sides including a normally extending upper lip (74, Figure 6) and a normally extending lower lip (84, Figure 6), each of said sides including a longitudinal groove (18, Figure 6) defined between the upper and lower lips, the groove including an inner most surface representing the deepest portion of the groove, the upper lip extending further from the inner surface than the lower lip (Figure 1A).

Claims 2, 3, 12, and 13:

The upper lip extends at least 20 percent further from the innermost surface than the lower lip (Figure 1A).

Claim 4:

The similarly configured sides are located on generally opposite sides of the body (Figure 6).

Claim 5:

The upper lip has a rounded distal portion (top corner of the board, Figure 1A).

Claim 7:

The upper and lower lips present opposing inwardly facing surfaces cooperatively defining at least a portion of the groove.

Claims 10 and 16:

Claims 10 and 16 are product by process claims and do not further limit the structural features of the article.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 8, 9, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 6,314,699B1 to West

Claims 8, 9, 14:

While West does not specify the dimensions of the board or spacing between the boards, dimensions of decking boards and spacing between deck boards are considered a matter of design choice to one of ordinary skill in the art. Furthermore, West states that variations in size may be made by one of ordinary skill in the art without departing from the principles and concepts of the invention (column 6, lines 1-16). West's Figure 1A shows that if the deck board body has a thickness in the range of 0.5 to 2 inches, the inwardly facing surfaces of the groove would have a space falling within the range of 0.05 to .5 inch.

Claims 6 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 6,314,699B1 to West as applied to claim 1 and further in view of Timber Tech article (1998).

Claims 6 and 15:

While West discloses that the boards are formed of PVC (column 5, lines 6), West does not disclose that the body is formed of fiber and plastic. However, fiber-plastic decking boards are well known in the art. Timber Tech discloses a composite material of plastic and cellulosic fiber (page 1) for extrusion of custom profiled deck planks. In view of Timber Tech, it would have been obvious to one of ordinary skill in the art at the time the invention was made to form West's deck boards with a fiber-plastic composite for resistance to moisture, insects and the ability to receive finishing paints and stains.

#### ***Prior Art Made of Record***

US Patent 5,660,016A to Erwin et al. discloses extruded decking boards with similar sides, each side comprising a groove formed by a top lip which extends further than the underlying lower lip.

Other references disclosing grooved panels are made of record:

US Patent 5,941,040 to McAnallen et al.

US Patent 5,355,648A to Graver et al.

US Patent 5,123,225A to Goodworth


US Patent 4,169,340 to Watson.

***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Naoko Slack whose telephone number is (703) 305-0315. The examiner can normally be reached on Mon-Fri (6:00 am-2:30pm EST). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor Carl D. Friedman can be reached at (703) 308-0839. The fax phone numbers for the organization where this application or proceeding is assigned are (703)872-9326 for regular communications and (703) 872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

NS  
September 12, 2005

  
Naoko Slack  
Primary Examiner